

REMARKS/ARGUMENTS

Claims 1 to 49 remain in this application.

The specification of the parent application was objected to for adding new matter and the claims were rejected under 35 USC 112, first paragraph, for failing to comply with the written description requirement. The objection and rejection are moot in view of the filing of this Continuation-in-Part application.

The claims of the parent application were rejected under 35 USC 103(a) as being unpatentable over Chen et al. (WO 99/39042) and Chen et al. in view of Wiley et al. (US 4,409,280). Wiley et al. was cited for the teaching of a print layer disposed on a foam layer adjacent a film, the subject matter of parent application claims 37, 38 and 76. This subject matter is not claimed in the present application. Therefore, the rejection over Chen et al. in view of Wiley et al. is moot.

Present independent claims 1 and 12 require a rigid or semirigid film. The definition of these terms based on the Handbook of PVC Formulating, John Wiley & Sons, 1993 are set forth in paragraphs 0010 and 001 of the present specification. Chen et al. does not teach or suggest this feature. Chen et al. teach a wear layer which is applied to the substrate and cured, and not a film. As stated at page 10, line 1, of Chen et al., the “wear layer base coat preferably comprises a flexible, thermosettable, polymer composition” and at page 14, lines 12 to 19, the “wear layer can be made of any suitable material known in the art for producing such wear layers. ... The dry film thickness of the PVC layer is not critical Means to apply the wear layer ... are not limited to, a reverse-roll coater. Once the wear layer is applied ..., the wear layer is cured.” Clearly,

Chen et al. does not teach or suggest a rigid or semirigid film. The wear layer of Chen et al. does not meet the definition of rigid or semirigid.

Present independent claim 24, as well as dependent claims 2, 13 and 35 require the thickness of the discontinuous layer to be “between about 0.1 mils and less than about 0.5 mils.” Chen et al. clearly teaches that the thickness of their top coat is “from about 0.5 mil to about 2.0 mils, more preferably, from about 0.9 mil to about 1.3 mils” (page 16, lines 29 and 30). Further all of their examples fall within this range.

In the middle of page 4 of the Office Action, dated October 22, 2003, in the parent application, the Examiner admits that “Chen et al. fails to disclose the discontinuous layer having a specific thickness between 0.1 mils and less than 0.5 mils.” She argues that

“Chen et al. does teach a discontinuous layer having a thickness of from about 0.5 mil to about 2.0 mils (see page 16, lines 29-30). Therefore, the optimum range of thickness would be readily determined through routine experimentation by one having ordinary skill in the art depending on the desired end results as shown by Chen et al. Thus, it would have been obvious to one of ordinary skill in the art at the time the applicant’s invention was made to have provided the discontinuous layer in Chen et al. with a thickness ranging between about 0.1 mils and less than 0.5 mils, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art absence of showing unexpected results. *In re Boesch and Slaney*, 205 USPQ 215 (CCPA 1980).

The Examiner’s reliance on *In re Boesch and Slaney* is inapposite. As stated by the Court of Customs and Patent Appeals in *In re Boesch and Slaney* at page 219,

“Considering, also that the composition requirements of the claims and the cited references overlap we agree with the Solicitor that the prior art would have suggested ‘the kind of experimentation necessary to achieve the claimed composition,’ This accords with the rule that discovery of

an optimum value of a result effective variable in a known process is ordinarily within the skill of the art.”

(Citations omitted, emphasis supplied.) The present claims do not overlap the range disclosed in Chen et al. Optimizing the thickness of the disclosed Chen et al. top coat will not lead one of ordinary skill to the presently claimed thickness outside of the thickness range of Chen et al. One ordinary skill in the art would optimize the thickness within the range disclosed by Chen et al. There is no suggestion in Chen et al. to experiment outside the disclosed range.

Not only does Chen et al. teach away from the claimed range (preferring a thickness of about 0.9 mils to about 1.3 mils over the range of about 0.5 mil to about 2.0 mils, see page 16, lines 29 and 30), as the thickness of the top coat becomes thinner from 0.9 mils to 0.5 mils to less than about 0.5 mils, the performance degrades. The unexpected results is not improved performance, but that the thinner top coat performs adequately in a commercial product.

Present claims 3, 14, 25 and 36 require the thickness of the discontinuous layer to be between about 0.1 mils and about 0.45 mils. Present claims 4, 15, 26 and 37 require the thickness of the discontinuous layer to be between about 0.1 mils and about 0.4 mils. These claimed ranges clearly do not overlap the disclosed range of Chen et al. and are not obvious in view of Chen et al.

Present claims 10 and 44 require the film to be a vinyl film having less than 5 parts plasticizer per hundred parts by weight of the vinyl resin. This feature is neither taught nor suggested by Chen et al.

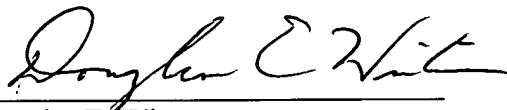
Present claims 11, 23, 33 and 48 require the discontinuous layer to comprise a flattening agent, a texturing agent and combinations thereof. This feature is neither taught nor suggested by Chen et al.

Present claim 34 claims a coated freestanding film. As discussed above with respect to claim 1 and 12, Chen et al. does not teach or suggest a freestanding film, but a wear layer that is applied to the substrate and cured.

For the reasons discussed above, it is believed that the present claims are allowable. Therefore, Applicants respectfully request that a timely Notice of Allowance be issued in the application.

Respectfully submitted,

2/20/04
Date

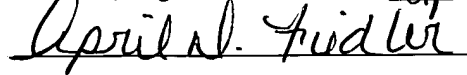


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